

AMENDMENT AND RESPONSE TO NON-FINAL OFFICE ACTION
U.S. Patent Application Serial No. 10/689,903
Filed: October 21, 2003
Page 11

REMARKS

This Amendment is a full and timely response to the Office Action dated June 15, 2006.

Claims 1-35 are pending in the application. Claims 1-35 have been rejected. Claim 29 has been amended. No new matter is added, and support for the amendment may be found throughout the specification and in the original claims. Upon entry of the present amendment, claims 1-35 will be pending in this application.

In the June 15, 2006 Office Action, the Examiner rejected all pending claims 1-35. The Applicants respectfully traverse the Examiner's rejections. For the reasons set forth below, the Applicants submit that the rejections should be withdrawn and that the claims are in condition for allowance.

I. Objections – Specification

The Examiner objects to the Abstract, "because it is missing the title of the invention." As support for the objection, the Examiner cites MPEP § 608.01(b). Applicants are not clear on the Examiner's objection, because MPEP § 608.01(b) does not require the title to be included in the Abstract. Further explanation of Examiner's objection to the Abstract is respectfully requested.

II. Claim Rejections – 35 U.S.C. § 101

The Office action rejects Claims 1-35 under 35 U.S.C. § 101 citing the claimed invention lacks patentable utility and does not produce a specific, nor substantial, useful result. The Examiner requested that the applicant include a final result of the present

AMENDMENT AND RESPONSE TO NON-FINAL OFFICE ACTION

U.S. Patent Application Serial No. 10/689,903

Filed: October 21, 2003

Page 12

invention that conveys a concrete, useful and practical utility as it relates to the claimed invention.

The Office Action rejected claims 1-35 under 35 U.S.C. § 101 as being allegedly lacking patentable utility. The Examiner states that the claims are directed to non-statutory subject matter, because the claims do not "produce a specific, nor substantial useful result." The Examiner notes that "[i]n order to overcome this rejection, applicant must include a final result of the present invention that will convey a concrete, useful, and practical utility as it relates to the claimed invention." The Applicants do not agree with the Examiner's characterization of the claims and the rejection of the claims under 35 U.S.C. § 101 and respectfully traverse this rejection. Utility under 35 U.S.C. § 101 is found if the claimed invention produces a useful, concrete, and tangible result. *See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, Official Gazette Notices, 22 November 2005, <http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm> (hereinafter *Interim Guidelines*).

Claims 1-35 do produce a useful, concrete, and tangible result and, therefore, do meet the patentability requirement set out by § 101. The Federal Circuit has held that for a claimed invention to satisfy the requirements of 35 U.S.C. § 101, it must produce a "useful, concrete, and tangible result." *State St. Bank & Tr. Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373-74 (Fed. Cir. 1998). In its *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, the USPTO states that the Examiner should weigh the aforementioned factors to determine whether 35 U.S.C. § 101

AMENDMENT AND RESPONSE TO NON-FINAL OFFICE ACTION
U.S. Patent Application Serial No. 10/689,903
Filed: October 21, 2003
Page 13

is met. *See Interim Guidelines*. Because the Applicants' invention meets each of the three factors, as explained below, claims 1-35 are patentable under 35 U.S.C. § 101.

A. Useful

First, the Applicants' claimed invention is useful. For this criterion to be met, the Patent Office requires a claimed invention's utility to be "specific, substantial, and credible." *See* M.P.E.P. § 2107(II)(A)(3); *Interim Guidelines*. The M.P.E.P. describes a "specific and substantial utility" as excluding "throw-away," "insubstantial," and "nonspecific" utilities. § 2107(II)(B)(1)(i). The Applicants' claimed invention cannot be categorized as any of these three types of exclusions. Rather, it has the specific utility of determining the meaning of an article, such as a web page, or determining a concept associated with a region in the article and matching that meaning or concept with an item, such as a keyword or an advertisement. The claimed invention is useful, for example, because items, such as advertisements or keywords may be matched to articles, such as web pages, or a region of the article. Therefore, the Applicants' claimed invention is useful, because it has a specific and substantial utility.

B. Concrete

Second, the Applicants' claimed invention is concrete. For this factor to be met "the process must have a result that can be substantially repeatable or the process must substantially produce the same result again." *Interim Guidelines*. The Applicants' claimed invention meets this criterion, because an item, such as a keyword or advertisement is matched with a meaning associated with an article or a concept associated with a region of an article. When these methods are embodied and followed,

AMENDMENT AND RESPONSE TO NON-FINAL OFFICE ACTION

U.S. Patent Application Serial No. 10/689,903

Filed: October 21, 2003

Page 14

the process of matching items with the meaning of an article or a region of the article is repeatable. Therefore, the Applicants' claimed invention is concrete, because it produces a result that is substantially repeatable.

C. Tangible

Third, the Applicants' claimed invention is tangible. This requirement "does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing." *Interim Guidelines*. Rather, the claim must set out a "practical application" that produces a "real-world result." *Id.* The Applicants' claimed invention sets out a practical application in claims 1, 14, and 28 (and, thus, to their respective dependent claims) by matching an item, such as a keyword or advertisement, with the meaning of an article, such as a web page, or a concept associated with a region of the article. By this matching, an advertisement can be selected and displayed associated with the article or region of the article. Thus, because the Applicants' claimed invention has a practical application and produces real-world results, the claimed invention is tangible.

Therefore, because each of the three criteria for patentability under § 101 are met, the Office Action rejection to these claims is believed to be traversed, and claims 1-35 are in condition for allowance.

III. Claim Rejections – 35 U.S.C. § 102

Claims 1-35 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,484,161 to Chipalkatti et al. ("Chipalkatti"). In order to anticipate a claim under 35 U.S.C. § 102(e), "the reference must teach each and every element of the

AMENDMENT AND RESPONSE TO NON-FINAL OFFICE ACTION

U.S. Patent Application Serial No. 10/689,903

Filed: October 21, 2003

Page 15

claim.” M.P.E.P. § 2131. Chipalkatti does not teach or suggest all of the elements of any of the Applicants’ claims. Thus, the Applicants respectfully traverse these rejections.

Chipalkatti relates to a system for performing online data queries. Specifically, Chipalkatti discloses a system for performing search queries for information contained in “yellow pages,” such as the GTE Superpages. Chipalkatti, 5:1-24, 5:55-67. The Examiner states that Chipalkatti discloses “identifying a plurality of regions in the source article” at col. 5, lines 58-61. This section of Chipalkatti does not so disclose. Rather, it discloses that the GTE Superpages Internet site contains a variety of information that can be searched by a user. Further, the Examiner states that Chipalkatti discloses “analyzing local concepts associated with any unrelated regions to determine relevant concepts” at col. 35, lines 43-57. This section of Chipalkatti does not so disclose. Rather, it discloses determining categories into which retrieved documents relevant to a user’s search query fall. Moreover, this section discloses comparing categories from the retrieved documents to the user’s search query to determine if any categories are not relevant to the search query.

The Examiner also states that Chipalkatti discloses “eliminating the local concepts associated with any unrelated regions to determine the relevant concepts” at col. 35, lines 1-10. This section of Chipalkatti does not so disclose. Rather, it discloses determining whether the documents or business listings retrieved are associated with more than one category. If the business listing retrieved are associated with a single category, then the business listings may be displayed. If the business listings retrieved are associated with more than one category, then the list of categories may be displayed.

AMENDMENT AND RESPONSE TO NON-FINAL OFFICE ACTION

U.S. Patent Application Serial No. 10/689,903

Filed: October 21, 2003

Page 16

Additionally, the Examiner states that Chipalkatti discloses "analyzing the relevant concepts to determine a source meaning for the source article" at col. 35, lines 25-37. This section of Chipalkatti does not so disclose. Rather, it discloses pre-processing steps for classifying and establishing query result sets for common search queries by designating common terms.

Although not specifically discussed by the Examiner, Chipalkatti further discloses a system for targeting banner advertisements based on a user's search query that are displayed to a user of the system. *See, e.g.*, 61:26-64:21. However, Chipalkatti discloses matching advertisements to a user's search query and does not disclose, *inter alia*, matching a meaning of a source article with an item meaning associated with an item, such as a keyword or advertisement, as claimed in the present invention.

Since Chipalkatti does not include all of the elements of claims 1, 14, and 28, the Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 14, and 28.

Claims 2-13 depend from claim 1, claims 15-27 depend from claim 14, and claims 29-35 depend from claim 28 and are patentable over Chipalkatti for at least the same reasons as stated above for claims 1, 14, and 28. Therefore, the Applicants respectfully request that the Examiner withdraw the rejection of claims 2-13, 15-27, and 29-35.

AMENDMENT AND RESPONSE TO NON-FINAL OFFICE ACTION

U.S. Patent Application Serial No. 10/689,903

Filed: October 21, 2003

Page 17

IV. Prior Art of Record

The Office Action states that the prior art made of record is considered pertinent to Applicant's disclosure. Applicant respectfully traverses the characterizations and relevance of these reference as prior art or otherwise, and respectfully reserves the right to present such arguments and other material should the Examiner maintain rejection of Applicant's claims, based upon the references made of record and not relied upon.

AMENDMENT AND RESPONSE TO NON-FINAL OFFICE ACTION
U.S. Patent Application Serial No. 10/689,903
Filed: October 21, 2003
Page 18

CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action of June 15, 2006. Reconsideration of the pending claims is respectfully requested in view of the foregoing amendments and the following remarks and Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner believes that there are any issues that can be resolved by a telephone conference, or that there are any informalities that can be corrected by an amendment, please call 404 815 6061.

Respectfully submitted,



Michael J. Turton
Reg. No. 40,852

KILPATRICK STOCKTON LLP
1100 Peachtree Street, Suite 2800
Atlanta, Georgia 30309-4530
Phone: 404 815 6061